

Appl. No. 09/752,141

Attorney Ref: 115699-29

Response to Office Action of: December 31, 2003

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REMARKS**1) Summary of the Office Action**

Claims 1 – 29 were pending in the application. Claims 19 – 27 were previously withdrawn from consideration as being non-elected. They are now cancelled to expedite prosecution of this case, with the applicant reserving the right to file a divisional case thereon. Claims 1 – 18 presently stand allowed. Claims 27 – 29 stand rejected.

2) Rejection of Claims 27 – 29

Claims 27 – 29 have been rejected under 35 USC 103(a) as being obvious given US Patent 5,757,566 of Stursberg ("Stursberg '566") in view of US Patent 4,516,614 of Grimhall et al. ("Grimhall '614") The applicant respectfully disagrees, and requests reconsideration of the present rejections.

As set out in MPEP 2142, *prima facie* basis for a rejection under 35 USC 103 requires a showing of the elements of a three part test. Those elements are (a) demonstration, in the objective art of record in the case of suggestion, motivation or incentive to combine or modify the reference or references in the manner proposed; (b) a demonstration that the resultant device would have a strong likelihood of success in arriving at the invention; and (c) a demonstration that the device so obtained would include all of the features of the claimed invention.

The applicant respectfully submits that (i) there is no suggestion, motivation, or incentive to combine the references as proposed in the rejection; and (ii) that the device would not include the features of the invention.

The Stursberg '566 reference relates to a plasma cutting apparatus. The Grimhall '614 reference refers to a method of slicing veneer. There does not appear to be any particular logical nexus between these two references, let alone a nexus that would give rise to the requisite suggestion, motivation, or incentive to combine. The applicant notes that the Office Action is required to provide a thorough explanation of why a person skilled in the art, having no knowledge of the presently claimed invention, would be motivated to combine these references, particularly when they are taken from seemingly disparate fields.

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Further, the conveyors of Grimhall '614 are used in conjunction with a knife that is mounted to slice off the bottom of the workpiece as the workpiece (e.g., a log) passes thereover. (See Grimhall '614 at Col. 2, lines 55 - 57). If a movable bed were mounted on the Grimhall '614 device, a person skilled in the art might reasonably wonder what effect such a knife would have on the underside of that bed for carrying the workpiece. In that light, reading Grimhall '614 as a whole, as the law requires, the applicant respectfully submits that a person skilled in the art would not find, and would not be motivated to arrive at, the presently claimed invention.

Second, neither Stursberg '566 nor Grimhall '614 have a movable bed. Stursberg '566 employs infeed and outfeed rollers 16 for supporting the flat plate stock (See Stursberg '566, col. 4, lines 37 et seq.) Grimhall '614 likewise employs a series of conveyors. (See Grimhall '614, Col. 2, lines 40 - 54). The claim requires not a circuit of conveyors, as shown by Grimhall '614, but a movable bed for supporting a workpiece, and a path defining a circuit about which the movable bed can move. Neither Grimhall '614 nor Stursberg '566 has a movable bed as claimed, or a path for a movable bed to follow. Whether taken singly or in combination, neither Grimhall '614 nor Stursberg '566 show, describe, or suggest a bed for supporting a workpiece and a path defining a circuit about which the bed may move. In that light, the combination of references proposed in the Office Action would lack at least one element of the presently claimed invention of claim 27.

Inasmuch as claims 28 and 29 depend from claim 27, the applicant respectfully submits that *prima facie* grounds for a rejection under 35 USC 103 have not been established for the rejection of these claims. As such, the applicant respectfully requests reconsideration and allowance of all of pending claims, that is claims 1-18 and 27 - 29 is earnestly requested.

Respectfully submitted,



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